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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,945	02/10/2004	Alexander B. Beaman	P1913-C2/522C-2	4257
29141 7590 03/19/2009 SAWYER LAW GROUP LLP 2465 E. Bayshore Road, Suite No. 406 PALO ALTO, CA 94303				
EXAMINER				
BRIER, JEFFERY A				
ART UNIT		PAPER NUMBER		
2628				
NOTIFICATION DATE		DELIVERY MODE		
03/19/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent@sawyerlawgroup.com

### Office Action Summary

**Application No.**

10/776,945

**Applicant(s)**

BEAMAN ET AL.

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/12/2009 has been entered.

### ***Response to Amendment***

2. The amendment filed on 01/12/2009 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 01/12/2009 have been fully considered but they are not persuasive.

The arguments concerning the 35 USC 112 rejections are not fully complete because cancelled claims 8-12 corresponds to new claims 22-26 which have been written to avoid the previous 112 rejections. However, new 35 USC 112 issues are addressed below.

The argument concerning double patenting is not persuasive because the 01/12/2009 terminal disclaimer does not reference US Patent No. 5,926,189. The double patenting warning is still in effect and an obvious type double patenting analysis

will be held in abeyance until claims are clarified. Applicant is requested to maintain a clear line of demarcation between the claims of this application and the claims of US Patent No. 5,926,189 or file a terminal disclaimer correctly identifying US Patent No. 5,926,189.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19:

This claim claims the invention is a method in a single computer system, however, the specification describes a single computer system having graphics system 24, glyph server 10, and operating system 26 where the glyph server 10 performs the method. Thus, the claim is unclear which element is performing the method.

At line 4 "one software client" is claimed which is unclear which element receives a request since elements 12, 14, 16, 18, 20, 22, 24, and 26 are not described as being a client and elements 12, 14, 16, 18, 20, and 22 are a part of a glyph server 10. Applicant needs to use claim terms which are consistent with the terms of the specification.

At line 8 "the single computer system" is claimed to be in "communication" with the glyph cache 14. It is unclear which element is the claimed "the single computer system" at this line because:

- 1) the public format font data tables are stored in system memory (applicants specification at page 6 line 20) and
- 2) the glyph cache unit 14 is a part of the "the single computer system".

At line 12 the element receiving the glyph data descriptions in "the single computer system" is unclear.

At line 16 the data shared is unclear because "the public format font data tables are stored in system memory" (applicants specification at page 6 line 20) and are not seen to be shared such that a "decrease glyph construction time" occurs by the glyph server 10.

Claim 20:

At line 2 "the open font architecture module" lacks antecedent basis in the claim since parent claim 19 claims "open font architectural services".

At line 2 "module in and" appears to be missing claim limitations. See claim 22 line 10.

Claim 21:

This dependent claim does not correct the issues present in parent claims 20 and 19.

Claim 22:

This claim claims the invention is a method in a graphics system, however, the specification describes single computer system having graphics system 24, glyph server 10, and operating system 26 where the glyph server 10 performs the method. Thus, the claim is unclear which element is performing the method.

At line 10 "the open font architecture unit" lacks antecedent basis in the claim since previously at lines 8-9 "open font architecture services" was claimed.

At line 14 both "the open font architecture services unit" and "the font scaler unit" lacks antecedent basis in the claim.

Claims 23-26:

These dependent claims do not correct the issues present in parent claims 20 and 19.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 19-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19-21:

These claims claim the invention is a method in a single computer system, however, the specification describes a single computer system having graphics system 24, glyph server 10, and operating system 26 where the glyph server 10 performs the method of the glyph server 10. Thus, these claims are claiming the method generically while the specification described a species of the genus.

Applicants specification at page 2 lines 3-5 describes (emphasis added by underlining):

Accordingly, a need exists for a flexible and portable system that allows accurate and efficient manipulations of textual data in a graphics system. The present invention addresses such a need.

Applicants specification at page 3 lines 15-21 describes (emphasis added by underlining):

With these aspects of the present invention, an integration of components necessary to render lines of glyphs is produced. The integration of these components results in a flexible and portable unit that acts as a resource for calls for glyphs between a graphics and operating system, thus acting a sort of glyph server for the systems. These and other advantages of the aspects of the present invention will be more fully understood in conjunction with the following detailed description and accompanying drawings.

Figure illustrates the glyph server 10.

Applicants specification at page 14 lines 14-22 describes (emphasis added by underlining):

Thus, with the present invention, the ability to produce enhanced functionality for glyph rendering is achieved. Further, the present invention provides an integrated glyph server that is portable and flexible to produce the glyph renderings. Additionally, the glyph server is readily adaptable for use with a variety of graphics systems and is thus seemingly unlimited in

the numbers of renderings capable of being produced, the numbers of renderings depending upon the graphics system itself. Also, new scalars and new font formats are easily added to the system of the present invention without modifying the major components of the system, which improves adaptability and provides an expandable glyph production system.

Thus, applicants described invention is the integration into a portable and flexible unit a glyph server 10 performing the functions of glyph server 10.

Recently Federal Circuit decisions concerning generic claims:

Carnegie Mellon University v. Hoffmann-La Roche Inc., 88 USPQ2d 1233 (Fed. Cir. 2008), U.S. Court of Appeals Federal Circuit Nos. 2007-1266, -1267, Decided September 8, 2008, 541 F3d 1115; and

In re Alonso, 88 USPQ2d 1849 (Fed. Cir. 2008), U.S. Court of Appeals Federal Circuit, No. 2008-1079, Decided October 30, 2008, 545 F3d 1015.

A recently Federal Circuit decision concerning added generic claims: ICU MEDICAL, INC. v. ALARIS MEDICAL SYSTEMS, INC., No. 2008-1077, DECIDED: March 13, 2009.

Federal Circuit decision concerning original generic claims:

LizardTech Inc. v. Earth Resource Mapping Inc., 76 USPQ2d 1724 (Fed. Cir. 2005); and

Lizardtech Inc. v. Earth Resource Mapping Inc., 77 USPQ2d 1391 (Fed. Cir. 2006).

Thus, legal precedent requires that a genus be described in such a manner to convey that applicant had possession of the genus in order to claim the genus and as



discussed in ICU MEDICAL a contention that a genus would have been obvious is not enough to overcome this legal standard.

Claims 22-26:

These claims claim the invention is a method in a graphics system running on a computer system, however, the specification describes single computer system having graphics system 24, glyph server 10, and operating system 26 where the glyph server 10 performs the method. Thus, these claims are claiming the method generically while the specification described a species of the genus. The discussion given above for claims 19-21 applies to claims 22-26.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7661. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Art Unit 2628